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| 09/888,145 | 06/22/2001 | John M. Shanahan | 65043-0038 | 8181 |

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RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

EXAMINER

MENDIRATTA, VISHU K

| ART UNIT | PAPER NUMBER |
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3711

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/888,145
Filing Date: June 22, 2001
Appellant(s): SHANAHAN, JOHN M.

John M. Shanahan
For Appellant

MAILED
OCT 01 2003
GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/14/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement of the grouping of claims is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|------------------|-----------------|----------------|
| 3,770,278 | Mueller | 11-1973 |
| 3,768,813 | Reynolds | 10-1973 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,3-6,8,10,11,13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller.

Mueller teaches a strip in a fortune like cookie and strip having printed matter (Fig.3).

Mueller teaches all limitations of these claims except that it does not teach predetermined denomination and suit as indicia. The only difference between applicant's strip and Mueller resides in the meaning and information conveyed by the printed matter. Such differences are considered unpatentable, Ex parte Breslow, 192 USPQ 431. In order to create a variation, it would have been obvious to print predetermined denomination or any other theme related indicia. One of ordinary skill in art at the time the invention was made would have printed suit and denomination on the strip.

Applicant may note that limitations in claims 9 and 10 are rules for playing and do not further add any limitation to the structure of the apparatus claimed.

Claims 2,7,9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Reynolds.

Mueller teaches all limitations of these claims except that it does not teach perforation on strips for separation of cards. Reynolds teaches perforation on strips for card

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separation. In order to detach cards from the strip, it would have been obvious to use perforation. One of ordinary skill in art at the time the invention was made would have used perforation for easy separation of cards from the strip.

(11) *Response to Argument*

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that there is no suggestion in the prior art or reasoning in the rejection that discloses "a card game" or "a novelty item" that includes at least one card in a fortune cookie. Arguments are not persuasive.

Mueller fortune cookie game contains a strip determining a chance in a chance game. Accordingly the strip of paper demonstrated as in Fig.4 is well within definition of a game card.

The rejection also clearly cites Ex Parte Breslow 192 USPQ 431. A comparison of applicant's claims to the prior art Mueller indicates that the only difference resides in the meaning and information conveyed by the printed matter on the strip of paper.

Examiner takes the position that suits and denominations are symbols that convey information. For that matter indicia on Mueller's strip also has denominations such as K and A as in card games (see Fig.2), and letters in black color that can be considered suit as in game cards.

Examiner further takes the position that "predetermining suits and denominations" pertains to rules of playing the game and do not add any further limitation to the apparatus in the claim. Such limitations are intended use of the strip and do not add any

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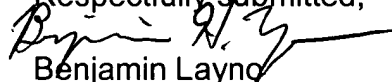
further limitation. For the purpose of responding to the argument, Mueller strips are also printed with "predetermined indicia".

The argument that Mueller and Reynolds combination lacks motivation, are not persuasive. Reynolds teaches concealing cards that are separated by perforation indicating a possibility of separating cards as required (Reynolds 2:40-42). Mueller teaches concealing a strip of paper in a cookie. In order to easily detach cards, it would have been obvious to provide a strip with perforation between cards for separating and for playing the game.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Roberts (2,254,545) teaches a predetermined hand inside concealment.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Benjamin Layno
Primary Examiner

September 23, 2003

Conferees

Paul Sewell, SPE.....

Vishu Mendiratta Examiner.....

RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610